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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/763,141

01/17/2002

Jin-Yong Joo

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/763,141	<b>Applicant(s)</b> JOO ET AL.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008 and 29 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This action is responsive to the paper(s) filed 9/5/2008 and 9/29/2008.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-9, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viral Marketing (Steve Jurvetson and Tim Draper) in view of Goldhaber et al (US5794210).**

3. Regarding claims 1, 2, 4, 9, Viral Marketing teaches the concepts of providing free email services that include viral advertising embedded within from one user to his (friends) recipients. These messages “imply endorsement” from the sender to the user and therefore are a more powerful form of advertising over ads from unknown senders. Viral Marketing also teaches that the “customers (senders) do the selling” of the advertised products and the concept is likened to multi level marketing where customers are treated like “distribution partners” and are paid for their word of mouth viral advertising. Viral Marketing does not mention compensating the recipient of the viral advertising. However Goldhaber et al teaches the concept of negatively priced information whereby consumer who consume advertising information are paid for their (tracked/monitored) attention [abstract]. In particular, readers of emails can be paid for

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their attention in reading emails [col 6 lines 3-23]. It would have been obvious to one of ordinary skill at the time of the invention to have tracked the sending, delivery and display of such viral advertising and paid not only the sender as suggested by Viral Marketing, but also the recipients as taught by Goldhaber et al. Regarding the activation of the advertising via an "activating member" included with the email, Official Notice is taken that it is well known to provide attachments with emails and it would have been obvious to one of ordinary skill at the time of the invention to have provided the viral advertising as an attachment, or other means, so that other well known media formats can be used for the advertising – such as audio, video, images, HTML backgrounds, rich media, etc. This would provide a more attractive advertisement over plain text. Rendering any of these formats by the recipient (or via a preview by the sender) can be considered to represent “activation” of the advertising content.

However, Official Notice is further taken that attachments are capable of being opened (activated) by actuating a graphical user interface (GUI) element such as an icon which acts as a clickable button. Such an icon/button is taken to be an “activating member” included as part of the email, but separate from the advertisement; it is a “separate” link to the attached advertisement. Regarding the download of emails by the sender, the well-known concept of web mail as mention by Viral Marketing inherently indicates that email messages are downloaded for editing and then delivered by a server. Likewise, use of an email client provides delivery of emails from the sender PC to a server and ultimately to a user’s PC who may also optionally use webmail or a local mail client.

4. Regarding claims 3, 5, 8, given Viral Marketing's teaching that the sender is endorsing the product advertised, it would have been obvious to one of ordinary skill at the time of the invention to have enabled the sender to have chosen an advertisement having content that the sender was comfortable endorsing and/or that the sender believes his recipient/friend would find beneficial. It would be predictably senseless and discouraging to have been forced to send an advertisement for a product or company for which the sender (or if the sender is aware, the recipient) carries ill-feelings.

5. Regarding claim 6, it would have been obvious to one of ordinary skill at the time of the invention for any entity to have sent an advertisement with the proposed system including a lottery provider who entices prospects with vouchers/coupons for free lottery tickets in an attempt to attract future lottery sales from the consumers.

6. Regarding claim 7, Official Notice is taken that SPAM or bulk emailing is a well known and fraudulent practice. It would have been obvious to one of ordinary skill at the time of the invention to have deprived bad actors of compensation where they are determined to be sending countless emails to limitless recipients in an attempt to fraudulently gain the system for revenue. Allowing payments to senders who SPAM others would not only be a waste of money, but would be paying for emails that would predictably be seen by the SPAM-recipients as unwanted, doing harm to the brand being advertised.

7. Regarding claims 12-17, the attachment icon/button is taken to be displayed with the body of the email and may be activated to switched from a hidden state to an activated attachment state where not only is the attached advertisement displayed, but

that the GUI attachment icon/button is shown on the screen at the same time as the email body. Doing so also provides the attachment in an activated state in the email.

### ***Response to Arguments***

Applicant argues that the Viral Marketing is involuntary and therefore does not teach choosing an ad. However, that NPL reference also likens the Viral Marketing to a multi-level marketing (MLM) system whereby customers are also active sellers, encouraging their friends to make purchases. As set forth in the action one of ordinary skill would find it obvious to enable a choice of ads for the sender, especially where the sender is to be an implied endorser of the advertised item. Endorsing products which are felt to be poor/unwanted products to either the sender or recipient would be an obvious shortcoming of such a system, ripe for improvement through known techniques of active endorsement (i.e. choosing an ad to endorse).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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Primary Examiner  
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jdc